

REMARKS

Claims 1-46 are pending in this application. No claims have been allowed. The Examiner rejected claims 1-46 under the judicially created doctrine of obviousness-type double patenting, objected to claims 1-10 because of an informality, rejected claims 1, 2, 4-12, 14-22, and 24-46 under 35 U.S.C. § 102(e), and rejected claims 3, 13, and 23 under 35 U.S.C. § 103(a). In this Response, the Applicants have amended claim 1 to correct the informality indicated by the Examiner. No new matter within the prohibition of 35 U.S.C. § 132 has been added. The Applicants kindly request reconsideration and allowance of the pending claims for the reasons detailed below.

1) Double Patenting:

The Examiner rejected claims 1-10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,714,132. The Examiner also rejected claims 11-19 [sic, 11-20] under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-37 of U.S. Patent No. 6,714,132. Next, the Examiner rejected claims 21-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-37 of U.S. Patent No. 6,714,132. Finally, the Examiner rejected claims 31-46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-37 of U.S. Patent No. 6,714,132. In making these rejections, the Examiner has indicated that a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly-owned with this application.

Without addressing the merits of the Examiner's double patenting rejection, the Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321. The Applicants have also enclosed a copy of the assignment for the instant application and of the recorded assignments for U.S. Patent No. 6,714,132. As evidenced by the assignments, the instant application and U.S. Patent No. 6,714,132 are commonly-owned. Accordingly, the Applicants respectfully request the Examiner to withdraw her double patenting rejection of claims 1-46 in light of the Terminal Disclaimer.

2) Claim Objections to Claims 1-10:

The Examiner objected to claim 1 and its dependent claims 2-10 based on an informality. Specifically, the Examiner noted that in claim 1, line 3, the phrase “encoded signal wireless signal” perhaps should be recited as “encoded wireless signal”. In response to this objection, the Applicants have amended claim 1 in accordance with the Examiner’s suggestion.

3) Claim Rejections Based on the Flanagan Reference:

The Examiner rejected claims 1, 2, 4-12, 14-22, and 24-46 under 35 U.S.C. §102(e) as being anticipated by Flanagan et al., U.S. Patent Application No. 2003/0062996, published on April 3, 2003. This reference was the only art cited by the Examiner in support of the rejection under 35 U.S.C. §102(e). The Examiner also rejected claims 3, 13, and 23 under 35 U.S.C. §103(a) as being unpatentable over Flanagan et al., U.S. Patent Application No. 2003/0062996. The Flanagan reference was also the only art cited by the Examiner in support of the rejection under 35 U.S.C. § 103(a).

In this Response, the Applicants submit for the Examiner’s consideration in support of the application’s patentability evidence entitled “Affidavit Under 37 C.F.R. § 1.131”. The Applicants respectfully suggest that this Affidavit establishes invention of the subject matter of the rejected claims in the United States of America before the effective date of the cited reference (the Flanagan reference) on which the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 are based. In particular, the attached Affidavit shows facts to establish reduction to practice of the invention before the effective date of the Flanagan reference.

Before discussing the contents of the Affidavit, the Applicants respectfully request the Examiner to note first the guidance of M.P.E.P. § 715.07, Facts and Documentary Evidence under the sub-heading “Establishment of Dates.” This portion provides the following:

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

In view of the guidance provided by MPEP § 715.07, the Applicants respectfully suggest that the removal of dates from an Exhibit to support an Affidavit under 37 C.F.R. § 1.131 does not render the evidence submitted as insufficient. Rather, the Examiner should still examine the body of the oath or declaration and consider whether the matter of dates has been taken care of by the content of the oath or declaration itself.

Moving now to the contents of the Affidavit, the Applicants request the Examiner consider numbered paragraph 5 of the Affidavit. In this paragraph, all three of the Applicants state that “we submit herewith and attach hereto Exhibit A, which is a redacted photocopy of the Disclosure of Invention that we prepared and submitted before September 28, 2001, to the NASA Langley Research Center Patent Counsel Office located in Hampton, Virginia, and that was received therein before September 28, 2001. Exhibit A is a redacted photocopy because dates have been blocked off. All of the dates redacted in Exhibit A are before September 28, 2001. These redacted dates include the dates originally provided in Sections 14 and 17, which contained dates corresponding to each enumerated stage of development of the invention.” The Affidavit thus provides that the conception of the invention evidenced by Exhibit A occurred before September 28, 2001. Accordingly, the Applicants respectfully suggest that, although the dates contained in Exhibit A have been blocked off, the matter of dates has been taken care of in the body of the oath of the Affidavit. Following the guidance of MPEP § 715.07, the Examiner should consider the Affidavit sufficient to establish a conception of the present invention in the United States before the effective date of the Flanagan reference.

Additionally, the Applicants draw the Examiner's specific attention to numbered

paragraph 9 of the Affidavit. In this paragraph, all three of the Applicants state that “a first generation prototype of the invention defined by claims 1-46 of the above-identified patent application was also built, assembled, and tested before September 28, 2001, as evidenced by the Disclosure of Invention of Exhibit A, which indicates that a prototype was developed in Sections 12, 14, and 17(d). (See sections entitled ‘State of Development,’ ‘Indicate the Dates or the Approximate Time Period During Which This Innovation Was Developed’ and ‘Development History.’) This same first prototype also worked for its intended purpose before September 28, 2001, as evidenced by the Disclosure of Invention of Exhibit A, which indicates the first successful operational test was completed in Building 1299, Room 138 of the NASA Langley Research Center in Section 17 (e) under ‘Development History.’” The Affidavit thus provides that the reduction to practice of the invention as evidenced by Exhibit A occurred in the United States before September 28, 2001. Again, the Applicants respectfully assert that, although the dates contained in Exhibit A have been blocked off, the matter of dates has been taken care of in the body of the oath of the Affidavit. Following the guidance of MPEP § 715.07, the Examiner should consider the Affidavit sufficient to establish a reduction to practice of the invention given in claims 1-46 in the United States before the effective date of the Flanagan reference. In view of the evidence submitted in this Affidavit, the Applicants respectfully request the Examiner to reconsider and withdraw her previous rejection based on the Flanagan reference.

CONCLUSION

In view of the above Response, attached Terminal Disclaimer, and Affidavit Under Rule 1.131, the Applicants submit that all pending claims in the instant application are in condition for allowance. The Applicants respectfully request an early action to this end.

Respectfully submitted,

DECEMBER 9, 2004

Date

Kurt G. Hammerle

Kurt G. Hammerle
Registration No. 36,819
NASA Langley Research Center
Mail Stop 141
Hampton, VA 23681-2199
757-864-2470
Customer No. 23351